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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/611,776

06/30/2003

Thomas V. Harris

T-6152

1883

34014

7590

02/24/2006

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EXAMINER

NGUYEN, TAM M

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/611,776

Applicant(s)

HARRIS ET AL.

Examiner

Tam M. Nguyen

Art Unit

1764

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


Tam M. Nguyen
Examiner
Art Unit: 1764

The argument that applicant's process uses a condensate feed having hydrocarbons boiling in the range of diesel, thus not requiring a two step process to produce base oil products as disclosed by Miller is not persuasive. Miller teaches that different fractions from a Fischer Tropsch process can be utilized in the dimerization zone (See col. 4, lines 28-29). It is reminded that the claimed process does not claim a condensate feed having hydrocarbons boiling in the range of diesel.

The argument that Miller gives no motivation to utilize a more effective adsorbent than acid clay to remove "substantially all" of the oxygenates and other impurities prior to oligomerization is not persuasive. According to the present specification, pages 9-10, the method of removing oxygenates is conventional and known. Also, the phrase "substantially all" would include a stream comprising up to 1500 wppm. In addition, Miller teaches that it is preferred that the feedstocks do not include an appreciable amount of oxygenates and/or other impurities (see col. 3, line 67 through col. 4, line 4). Furthermore, One of skill in the art would employ the method of either Vora or Gorawara in the process of Miller whether or not Miller acknowledges that oxygenates are interfered in the oligomerization process.

The argument that Miller teaches a first and a second dimerization while Applicants' process is a single step oligomerization process which does not use either fixed bed or a solid catalyst is not persuasive. The claimed process does not exclude a second dimerization step. Also, the second dimerization step of Miller is optional. Miller teaches that other catalyst such as an ionic liquid catalyst can be employed in the process. When an ionic liquid catalyst is employed, a fixed bed would not be used because the catalyst is not in a solidified state.

The argument that the preferred catalyst used by Miller is a nickel ZSM-5 catalyst is not persuasive because the teachings and disclosures of the prior art would have suggested to one of ordinary skill in the art, even including unpreferred embodiments. See *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976).

The argument that no basis for one skilled in the art to combine the teachings of Vora and Gorawara with that of Miller without an understanding of the importance of removing substantially all of the oxygenates present in a feed is not persuasive. As discussed above, Miller desires to remove oxygenate from the feed by any method wherein both Vora and Gorawara disclose a process for removing substantially all of oxygenates from a hydrocarbon feed. One of skill in the art would employ the method of either Vora or Gorawara in the process of Miller whether or not Miller acknowledges that oxygenates are interfered in the oligomerization process.

The argument that Hope does not mention oxygenates or describe methods for their removal is not persuasive because the examiner relied upon Hope to teach that the claimed catalyst is known in the art and such catalyst would be used in the process of Miller because of its effectiveness.